



Serial No. 09/690667

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: MacWilliams

Examiner: Monica Smith Carter

Serial No.: 09/690667

Group Art Unit: 3722

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Docket No.: 00725.0360-US-01

Title: LABEL HAVING FOLDING FEATURE

CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this Transmittal Letter and the paper, as described herein, are being deposited in the United States Postal Service, as first class mail, with sufficient postage, in an envelope addressed to: Commissioner for Patents, Alexandria, VA 22313-1450 on

12 December 2005

Jennifer Armstrong

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Signature

NOTICE OF APPEAL AND REQUEST FOR PRE-APPEAL REVIEW

Under pre-appeal Brief Conference Pilot Program

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant requests review of the final rejection in the above identified application. No amendments are being filed with this request.

Basis for Pre-Appeal Conference

The present invention sets forth at least two inventive concepts which are not shown or taught in the prior art. First, is the concept of a substantially planar label which has a fold gap. The second, is a multi-layer portion label which is single layer in the "gap" and the differential in transparency/opacity at the gap make is possible to visually discern the location of the gap. These features are expressed in the claims in several ways.

The significance of the first feature, of being substantially planar, is that the label can then be sent through a printer and the label indicia can be printed by machine. Being substantially planar means that the label substantially, in one plane, across its front and back faces. As pointed out in the prior response dated 1 Dec 2003 pages 7-8, Figure 5 of the Cunningham reference shows how that label construction is non-planar. Figure 5 shows an easily identifiable *step* in its surface (See dotted section on the left side of the label. The step is shown as a double line.)

Claim 1 of the present invention, provides specific structure which eliminates this stepwise discontinuity by specifying that the "...second layer covering substantially all of the second surface of the first layer..." which insures that the label will be substantially planar and thus capable of sheet feed printing.

Cunningham does not recognize this problem nor its solutions and for good reason: it is only useable as a roll feed system where sheet feed printing problems do not arise.

Cunningham is furthermore an opposite teaching because indicia is not printed on the label itself, but on the insert 31 which is never part of the label structure.

The examiner's position of simply saying that Cunningham "is planar" is unsupported by the its disclosure. Yes, Cunningham has a plurality flat discontinuous surfaces, but that cannot be characterized as a substantially planar label.

Claim 2 is further distinguishable in that it has an adhesive on the outer surface thereof. If Cunningham had such a surface, it could not receive insert 31, as its second surfaces would be stuck together! Cunningham's teaching is to put a preprinted indicia (31) *between* the second layers. The present claimed invention is the opposite. The indicia can be applied to the outside of the first layer (see claim 26, for example) but obviously not between second layers since they are adhesive, as claimed. Independent claim 11 also recites this feature. It is also noteworthy that there is no applicable argument asserted against claim 11. The argument (paragraph 4 of the Final Rejection) seems to be directed to claim 9.

The second feature mentioned above, relates to the concept of the gap being *visually discernable*. As to *this* feature which the examiner has completely misapplied Cunningham and appears to fully disregard M.P.E.P sec 2142 (a section based in case law under *In re Vaeck*, 947 F.2d 488, 20 USPQ2nd 1438 (Fed.Cir. 1991)).

The feature, of visual discernability, described in claims 9, 10, 13, 14, 22, 23, 30, 34 and 35, pointed out that the user can see the gap created by the two layers of material.

Cunningham teaches the opposite concept, i.e. that one can *feel* the gap, but not see it. Why? Because Cunningham only discloses the use translucent material in both its first and second layers. And it *must* only employ translucent layers because the label is meant to have an indicia insert 31 slid between those layers. If they were not translucent, the indicia would be blocked from view. (See column 3 line 57-58)

So Cunningham has no teaching of using visually discernable material, (nor darker material or security material as recited in some claims) to define , and find, the gap.

Nevertheless the examiner states on page 4 of the pending office action, that, "...it would be obvious to one having ordinary skill in the art...to provide any desired material having different characteristics such as color depending on the end result desired..." It is submitted that this is a complete misapplication of 35 U.S.C. sec 103. To leap from the contrary disclosure of Cunningham, which requires translucency, to the opposite result, which depends on enhanced opacity, is to re-write Cunningham into a reference which it is not. Then, to say that it is a mere design choice of a skilled artisan to select a "color", is ignore inventive the input to know why a "color" is important. If the United States Patent Office were to follow such a policy, then the variations between any reference and the claimed invention could always be attributed to "design choice" no matter how the prior art diverged from the cited references. Nothing would be patentable.

Clearly the examiner improperly extended the meaning of design choice to make up for the fact that the prior art is inapplicable to this unique solution to visually discerning the fold gap.

Furthermore, this solution has another benefit which is not applicable to the Cunningham: if the label is used to cover a prior label, its opacity is important in

preventing the underlying indicia from showing through. So, by creating a visually discernable gap, one necessarily controls opacity and thus gets the further benefit, not taught in Cunningham, of being able to block underlying indicia.

This document is intended to be brief and not reiterate all of the arguments previously submitted, but a review of the prosecution history shows that arguments we presented in response to the office action of 27 August 2002, mailed 18 December 2002 are also applicable to supporting these many of these claims. The panel is requested to make special note of page 7 last paragraph through page 9 thereof, where the examiner's design choice argument is fully traversed.

It is therefore respectfully requested that the claims as presented now be allowed or that the prosecution of these claims be re-opened in a non final action.

If a telephone conference would be helpful in resolving any issues concerning this communication, please contact Applicant's attorney of record, Michael B. Lasky at (952) 253-4106.

Respectfully submitted,

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Date: 12 December 2005

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